

III. REMARKS

Claims 1-35 are pending in this application. By this amendment, claims 1, 7, 13, 16, 22, 26 and 31 have been amended. No new matter is believed added. These amendments are being made to facilitate early allowance of the presently claimed subject matter. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the amendment and the following remarks is respectfully requested.

Entry of this Amendment is proper under 37 C.F.R. 1.116(b) because the Amendment: (a) places the application in condition for allowance as discussed below; (b) does not raise any new issues requiring further search and/or consideration; and (c) places the application in better form for appeal. Accordingly, Applicants respectfully request entry of this Amendment.

In the Office Action, claims 1-35 are rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite. Claims 1-35 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Puri (U.S. 6,064,982), hereafter “Puri.”

A. REJECTION OF CLAIMS 1-35 UNDER 35 U.S.C. §112

The Office has asserted that claims 1-35 are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended claims 1, 7, 13, 16, 22, 26 and 31 to include, in the body of the claims, determining

whether to remove an entity software application. Applicants assert that this amendment further clarifies the invention. Accordingly, Applicants request that the rejection be withdrawn.

B. REJECTION OF CLAIMS 1-35 UNDER 35 U.S.C. §102(e)

With regard to the 35 U.S.C. §103(a) rejection over Puri, Applicants assert that Puri does not teach or suggest each and every feature of the claimed invention. For example, with respect to currently amended claim 1, and similarly claimed in independent claims 7, 13, 16, 22, 26 and 31, Applicants submit that Puri fails to teach or suggest, *inter alia*, determining whether to remove an entity software application. This amendment is evident in and supported by, *inter alia*, page 1, line 19 to page 2, line 7. Instead, as stated in a previous paper, the needs identification of Puri is directed toward selection of new products and does not teach or suggest determining whether to remove products that are currently used by the business entity. In contrast, the claimed invention includes "...to determine whether to remove an entity software application." Claim 7. As such, the analyzing of the claimed invention is not merely directed toward selection of new products as is Puri, but instead to analyzing software application needs of a business entity to determine whether to remove an entity software application that is currently being used by the business entity. Thus, Puri does not teach the analyzing of the claimed invention. Accordingly, Applicants request that the Office's rejection be withdrawn.

Furthermore, Applicants assert that the Office's factual assertions, which amount to Official Notice, are not properly based upon common knowledge. The Office refuses to provide references, stating that Applicants have not specifically pointed out the supposed errors in the examiner's action. Accordingly, Applicants assert that, with respect to independent claims 1, 7,

13, 16, 22, 26 and 31, the step of inventorying a set of entity software applications that are currently used by the business entity is not obvious to one skilled in the art as asserted by the Office. This is because, *inter alia*, in a sales environment such as that of Puri, the salesman has no interest in knowing all of the software, but rather in selling his particular product. Furthermore, Applicants assert that formulating a set of questions related to an entity software application that is currently being used by the business entity based on a business strategy corresponding to the business entity, wherein the set of questions are tailored to assess the software application needs of the business entity and to measure how well the entity software application is meeting the software application needs is not obvious to one skilled in the art as asserted by the Office. This is because, *inter alia*, in a sales environment, such as that of Puri, the salesman wants to sell a product and not to measure the effectiveness of a current product vis a vis the software application needs of the business entity. Still further, with respect to claims 3 and 10, Applicants assert that the step of assigning a value for each possible response to the set of questions is not obvious to one skilled in the art as asserted by the Office. Accordingly, Applicants respectfully request that the Office support the finding with references that show these features.

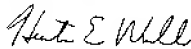
With respect to the Office's other arguments regarding dependent claims, Applicants herein incorporate the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicants submit that all claims are allowable based on their own distinct features. Since Puri does not teach or suggest each and every feature of the claimed invention, Applicants respectfully request withdrawal of these rejections based under 35 U.S.C. §103(a).

IV. CONCLUSION

In addition to the above arguments, Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,



Hunter E. Webb

Reg. No.: 54,593

Date: November 13, 2006

Hoffman, Warnick & D'Alessandro LLC
75 State Street, 14th Floor
Albany, New York 12207
(518) 449-0044

(518) 449-0047 (fax)

RAD/hew